

REMARKS

This communication is intended to fully comply with a good faith response to the Examiner's Office Action mailed December 16, 2005. This communication in conjunction with the attached Request For Continued Examination is expected to reopen prosecution of the instant application and terminate the pending Appeal process. The Examiner's actions are listed here in the order in which they are addressed.

- I. Claims 1-5, 12-19, and 26-28 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Soukup et al., Proc. Natl Acad Sci, 96:3584-3589 (1999) or Robertson et al., Nucleic Acids Research, 28:1751-1759 (2000).
- II. Claim 21 is objected to for allegedly being grammatically incorrect.
- III. Claim 7 is allowable.

I. The Claims Are Not *Prima Facie* Obvious

The Examiner has rejected Claims 1-5, 12-19, and 26-28 under 35 USC § 103(a) as allegedly being unpatentable over Soukup et al., Proc. Natl Acad Sci, 96:3584-3589 (1999) or Robertson et al., Nucleic Acids Research, 28:1751-1759 (2000). The Applicants disagree and argue that the Examiner has failed to make a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and *MPEP* § 2142; Establishing A Prima Facie Case Of Obviousness. The Examiner is reminded that if ONLY ONE of the above requirements is not met, then a *prima facie* case of obviousness does not exist.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have canceled Claims 1-5, 12-19, and 26-28. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants'

business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request that the Examiner withdraw the present rejection.

II. Claim 21 Is Grammatically Correct

The Examiner objects to Claim 21 because "A allosterically regulatable aptazyme" is grammatically incorrect. While the Applicants could argue otherwise, Claim 21 has been amended to recite "An allosterically regulatable aptazyme".

The Examiner is respectfully requested to withdraw the present objection.

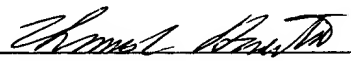
III. Claim 7 Is Allowable

The Examiner indicated in the Office Action (at pg 8) that Claim 7 is allowable.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

Dated: January 16, 2007

By: 
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